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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,876	01/10/2002	George Chanos	CHANOS.001CP1	7701
20995 7590 11/03/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
11/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/043,876

Applicant(s)

CHANOS ET AL.

Examiner

JAMES W. MYHRE

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 9, 11-20, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9, 11-20, 25, and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Amendment filed on August 27, 2009. The Amendment amended Claims 1-5, 8, 9, 11-15, 25, and 26, and cancelled Claims 6 and 24. Thus the currently pending claims considered below are Claims 1-5, 8, 9, 11-20, 25, and 26.

Claim Rejections - 35 USC § 112

2. The amendment filed on August 27, 2009 amended the claims to clarify Claim 1; thus, overcoming the rejection of Claims 1-6, 8, 9, and 11-14 under 35 U.S.C. 112, second paragraph, in paragraph 3 of the July 1, 2009 Office Action. Therefore, the Examiner hereby withdraws that rejection.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8, 9, 15, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 8 and 9 depend from cancelled Claim 6. Likewise, Claims 25 and 26 depend from cancelled Claim 24. Since the two cancelled claims (Claims 6 and 24) depended from independent Claims 1 and 15, respectively, the Examiner will consider

Claims 8 and 9 to depend from Claim 1 and Claims 25 and 26 to depend from Claim 15 in the below Office Action.

Appropriate correction is required.

b. Claim 15 includes the new limitation "said visibility not redirecting said consumer browser to display content other than said requests". There is insufficient antecedent basis for this ("visibility") in the claim. The Examiner notes that in the preceding phrase the requests become visible upon mouse-over by the consumer. Thus, the Examiner has interpreted the new limitation as meaning that the act of the requests becoming visible causes the browser to display only the requests and not any other content, at least not until the consumer selects one of the requests in the subsequent step. This, of course, would be inherent in that the previous step provides that the requests become visible. Thus, any information that becomes visible would be considered a request.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8, 9, 12, 13, 15, 17-20, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,014,634) in view of Perttunen (6,359,635).

Claims 1 and 15: Scroggie discloses a method and device, comprising:

a. displaying an advertisement on a browser of a consumer computer, wherein the advertisement includes one or more interactive symbols that the consumer may select to request additional information (column 1, line 56 - column 2, line 4; column 3, lines 15-24; and column 6, lines 10-14)(Scroggie discloses presenting an "offer browser index –page" that displays a plurality of offers (advertisements) from manufacturers. The offers are associated with "sub-offers", selectable by the user, to request additional information, such as coupons, rebates, information about the product; recipes using the product, etc. The Examiner notes that all of the offers (advertisements) are displayed in the browser window at the same time, thus each advertisement is displayed "while continuing to display content otherwise being displayed in said browser program".);

b. receiving a selection from the consumer requesting additional information (column 1, line 56 – column 2, line 4; column 3, lines 15-24; and column 6, lines 34-38) designating an email address (column 6, lines 42-45); and

c. sending the information to the email address (column 12, lines 55-58 and column 13, lines 7-10 and 31-40).

While Scroggie discloses selectable symbols within the advertisement for requesting additional information (e.g. sub-offers), it is not explicitly disclosed that the requests are hidden from view until the advertisement is activated by the consumer. However, Perttunen discloses a similar method and system for displaying

advertisements that include non-visible areas (column 21, lines 17-39 and column 33, lines 9-14) which become visible when the consumers select (mouse-over) the area (column 19, lines 61-65 and column 21, lines 40-67). The consumers may click on the now visible symbol to request additional information (column 21, lines 17-39). The Examiner further notes that using a mouse-over technique to display hidden lists, menus, options, and information has been common since at least the mid-1990s. For example, Bezos et al (US2002/0019856) discloses *"When a user moves a pointer over (e.g. mouse over) a category name, the information exchange system may display the sub-categories that are associated with the web page. The user can then select a sub-category to view information related only to web pages in that sub-category."*(page 3, paragraph 0022). Additionally, Rangan et al (6,006,265) discloses that *"A text annotation (not shown in Fig. 4) preferably appears about the object when the SUV 7 does a mouse-over on the object. These annotations can beneficially serve to impart additional, supplemental, information about the scene and/or the objects in it and/or the hotspot, such as , for example, the identity of a particular person in a depicted group of persons."* (column 26, lines 48-54).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention for Scroggie to use such "hidden" areas associated with the interactive symbols within the advertisement that allow the consumer to request additional information (i.e. select a sub-offer). One would have been motivated to hide these requests for information behind Scroggie's interactive symbols in order to de-

clutter the display, thus enabling the consumer to see and read the advertisement and other information being displayed in the browser window.

Claim 2: Scroggie and Perttunen disclose the device as in Claim 1 above, and Scroggie further discloses the email address entered by the consumer (column 6, lines 42-45).

Claims 3-5 and 17-20: Scroggie and Perttunen disclose the method and device as in Claims 1 and 15 above, and Scroggie further discloses upon selection of a request for information redirecting the consumer to a supplier of the promotion or provider of the promotion (i.e. advertiser)(column 1, line 56- column 2, line 4; column 3, lines 15-24; and column 7, lines 49-51) to receive additional information such as discounts, new releases, catalogs, special offers, etc. (column 2, lines 8-47; column 3, lines 51-65; and column 6, lines 38-43).

Claims 8, 9, 25, and 26: Scroggie and Perttunen disclose a method and device as in Claims 1 and 15 above, and Perttunen further discloses displaying the option on top of the advertisement or in a separate window, thus allowing either partial or full view of the advertisement and option at the same time (column 27, lines 21-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Scroggie to display the selectable options so as to only partial cover or not cover at all the advertisement. One would have been motivated to cover at the most

only part of the advertisement in order to allow the consumer to cross-check the additional information with the information in the advertisement.

Claim 12: Scroggie and Perttunen disclose a device as in Claim 1 above, and Scroggie further discloses the indicia includes a logo or mark of the source (column 11, lines 2-5),

Claim 13: Scroggie and Perttunen disclose a device as in Claim 1 above, and Scroggie further discloses at least one selection mechanism (e.g. mouse or keyboard) for selecting the request option (column 1, line 56 - column 2, line 4).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,014,634) in view of Perttunen (6,359,635) as applied to claim 1 above, and further in view of Rangan et al (6,006,265).

Claim 11: Scroggie and Perttunen disclose a device as in Claim 1 above, but do not explicitly disclose that the indicia is an animated object. However, Rangan discloses a similar device for displaying advertisement with hidden selectable options in which the advertisement and selectable options are hypervideos (e.g. animated objects) (column 26, lines 44-60). The Examiner also notes that animated icons/symbols on webpages have been known and used in the art since at least the early 1990's to draw the users attention to the icon/symbol. Thus, it would have been obvious to one having ordinary

skill in the art at the time of the invention for Scroggie to use animated objects in order to entice the consumer to request more information.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,014,634) in view of Perttunen (6,359,635) as applied to claim 1 above, and further in view of Wexler (5,960,409).

Claim 14: Scroggie and Perttunen disclose the device as in Claim 1 above, but do not explicitly disclose that the advertisement is a banner advertisement. However, Wexler discloses a similar device for presenting advertisement with selectable options to request additional information in which the advertisement is a banner advertisement (column 1, lines 49-60 and column 3, lines 55-58). Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention for Scroggie to use banner advertisements for his invention. One would have been motivated to use banner advertisements in view of their wide spread use on the Internet to entice consumers while they are browsing without covering up their viewing screen.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,014,634) in view of Perttunen (6,359, 635) as applied to claim 15 above, and further in view of Official Notice.

Claim 16: Scroggie and Pertunen disclose a device as in Claim 1 above and Scroggie further discloses the consumer entering the email address to which the requested information will be sent. However, it is not explicitly disclosed that the email address is of an acquaintance of the consumer. First, the Examiner notes that if the consumer in Scroggie is entering an email address other than his own, then he must know or at least be somewhat acquainted with the email address owner (even if all he knows about the owner is his email address). Second, no patentable weight is given to who owns the email account to which the information is being sent. And third, Official Notice is taken that it is old and well known within the arts for consumers to refer friends, relatives, and acquaintances to businesses. For example, many brides-to-be set up gift wish-lists at specific merchants listing their desired wedding gifts. They then send notification to their invitees of the merchant and his website. Their invitees may then go to the website, retrieve the wish-list which includes links (hidden or otherwise) to the products selected by the bride-to-be. Other links allow the invitee to maneuver through the site, annotated one of more items for purchase, and conclude the purchase transaction. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for Scroggie to allow the consumer to enter another person's email address. One would have been motivated to allow the consumer to enter in the email address of other acquaintances in order to provide information to someone who may be more interested in the advertised product, thus increasing the chance that a purchase will be made.

Response to Arguments

10. Applicant's arguments filed August 27, 2009 have been fully considered but they are not persuasive.

a. The Applicants Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Applicants make a general statement that "all of the patents individually or improperly combined fail to teach or suggest the elements of the claims." (page 8). However, the Applicant has failed to point out any specific claim limitation that is not taught by the cited references. The limitations discussed in the interview have been added to the expanded rejection above.

b. The Applicant also fails to traverse the Officially Noted facts. Traversal requires arguments (a rebuttal) as to why the Officially Noted facts were not well known at the time of the invention.

"A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." MPEP 2144.03

Bald statements such as: "the examiner has not provided proof that this element is well known" or "applicant disagrees with the examiner's taking of Official Notice and hereby requests evidence in support thereof", are not adequate and do not shift the burden to the examiner to provide evidence in support of Official Notice. Allowing such statement to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use the process of establishing a rejection of notoriously well known facts. In re Boon, 169 USPQ 231 (CCPA 1971)

Since the Applicant has not presented any arguments that it was not well known for a consumer to provide the email address of another person (e.g. a referral) at the time of the invention, the Official Notice still stands.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Burner et al (6,282,548) discloses a method and device for displaying supplemental information, such as an advertisement, along with the content on a webpage. The supplemental information may be viewed/selected using mouse-over techniques.

b. Rosen et al (7,353,246) discloses a method and device for displaying metadata on a webpage upon mouse-over of a hotspot on the page.

c. Bezos et al (US2002/0019856) discloses a method and device to display supplemental information about a product to a user. When the user mouses-over the product (advertisement) a plurality of selectable items appear that may be used to request various types of information/actions by the user, e.g. ordering, products parameters, product specifications, etc.

d. do Rosario Botelho et al (US2002/0069105) discloses a method and device for allowing a user to "pull down" menus showing product subcategories using mouse-over techniques.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W. M./
October 27, 2009

/James W Myhre/
Primary Examiner, Art Unit 3688